

**REMARKS/ARGUMENTS**

Of pending claims 1, 2, 4-12 and 14-20, all were rejected. The claims have been amended as noted above and new claims added. Reexamination and reconsideration of the claims is respectfully requested.

**Claims 1, 2, 4-12 and 14-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dobrovolny et al. in view of either Kunkel or Periman.** The Examiner states that Dobrovolny et al. discloses the Applicants basic inventive concept with the exception of using a spring mounted jaw member which can be adjusted without rotation of a threaded member. The Examiner further states that it would have been obvious to one of ordinary skill in the art to so modify the support arm of Dobrovolny et al. from the teaching of Periman or Kunkel. Such rejections are traversed in part and overcome in part as follows.

**Claim 1** has been amended for clarity to more specifically describe the claimed invention and such amendments have not been made in relation to the cited art. The present rejection does not establish prima facie obviousness under 35 U.S.C. §103. The Examiner bears the initial burden to establish and support prima facie obviousness. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). To establish prima facie obviousness, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification or combination. Thirdly, the prior art references must teach or suggest all of the limitations of the claims. The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in applicants disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (CAFC 1991). Applicants respectfully submit that prima facie obviousness has not been established because the Examiner's rejection fails to fulfill the above requirements.

Firstly, the Examiner has failed to show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings to derive the assembly of independent claim 1. The

Examiner states that such combination would be obvious because such modifications would enable easy adjustment while providing a firm grasp. The opinion that such modifications would be useful merely identifies that the invention would be patentable under 35 U.S.C. 101 and does not show suggestion or motivation to combine reference teachings.

Secondly, the Examiner has failed to establish that there is a reasonable expectation of success for the modification or combination of the references to derive the assembly of independent claim 1. For example, the clothespin described by Kunkel is described to hold clothes on a clothesline with enough force to resist opening pressures due to wind blowing the clothes or to pulling on the clothes from other causes (col. 1, lines 35-39). There is no indication that such a clothespin would be capable of successfully holding a heart stabilizer as described.

Thirdly, the Examiner has failed to show that the cited art references teach or suggest all of the limitations of the claims. For example, Applicants do not find that Dobrovolny et al. describes each of the elements set forth in claim 1 of the instant application with the exception of using a spring mounted jaw member. In particular, Applicants do not find mention of a heart stabilizer having a shaft which is claimed as an element in claim 1.

Thus, for the reasons stated above, *prima facie* obviousness has not been established in regards to claim 1 and Applicants believe **claim 1** is allowable along with dependent **claims 4-10**. Of note, amendments to claim 4 and claim 9 have been made for clarity and have not been made in relation to the cited art.

**Claim 11** has been amended similarly to claim 1 and such amendments have been made for clarity and have not been made in relation to the cited art. Therefore, Applicants believe claim 11 is allowable, for the same reasons as stated above in relation to claim 1, along with dependent **claims 14-15**.

In relation to **claim 16**, the present rejection does not establish *prima facie* obviousness under 35 U.S.C. §103. The Examiner bears the initial burden to establish and support *prima facie* obviousness as set forth above. Firstly, the Examiner has failed to show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings to derive the method

of independent claim 16. Secondly, the Examiner has failed to establish that there is a reasonable expectation of success for the combination of the references to derive the method of independent claim 16. For example, there is no indication that releasing of the clothespin described by Kunkel would secure such an end effector to a heart stabilizer. Thirdly, the Examiner has failed to show that the cited art references teach or suggest all of the limitations of the claims. For example, Applicants do not find mention in any of the references of the step of inserting a heart stabilizer into an end effector. Thus, for all of these reasons *prima facie* obviousness has not been established in regards to claim 16 and Applicants believe **claim 16** is allowable along with dependent **claims 18-20**.

Of note, amendments to claim 18-20 have been made for clarity and have not been made in relation to the cited art or the Examiner's comments. The Examiner states that all of the cited devices can be manipulated by one person. Regardless, the combination of these known devices does not lead to the method steps set forth in claim 16. Further, there is no description in any of the art or their combination of the specific steps performed by each hand, as set forth in claim 19. Also of note, claim 18 is not the inverse of claim 19 and is considered patentable distinct as an alternative embodiment.

#### THE ADDED CLAIMS

Claims 21-26 have been added. Claims 21-23 depend from claim 16 and claims 24-26 depend from claim 1. Therefore, these claims are considered allowable for at least the reasons stated above in relation to claim 16 and claim 1.

Appl. No. 09/675,824  
Amdt. dated July 20, 2004  
Reply to Office Action of March 29, 2004

PATENT

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Lynn M. Thompson  
Reg. No. 47,991

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400  
Fax: 415-576-0300  
Attachments  
LMT:jke  
60228692 v1